

## REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on March 8, 2005, the Examiner rejected claims 21-29, 31-38 and 40-41 under 35 U.S.C. §103(a) as being unpatentable over Evans (U.S. Patent No. 5,924,074, hereinafter “Evans”) in view of Feldon et al (U.S. Patent No. 5,732,221, hereinafter “Feldon”) and Lavin et al (U.S. Patent No. 5,772,585, hereinafter “Lavin”) and further in view of Provost et al (U.S. Patent No. 6,341,265, hereinafter “Provost”). Accordingly, Applicant respectfully provides the following:

The standard for a Section 103(a) rejection is set forth in M.P.E.P. 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant submits that the requirement for “...some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings” is not met. Specifically, relating to this first criterion to establish a *prima facie* case of obviousness, M.P.E.P. 2143.01 indicates that the prior art must suggest the desirability of the claimed invention. However, the prior art does not suggest the desirability of the present invention as provided in claims 21-29, 31-38 and 40-41.

Additionally, M.P.E.P. 2143.01 provides:

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Neither the nature of the problem to be solved, the teachings of the prior art, nor the knowledge of persons of ordinary skill in the art provide a motivation to combine all of the references cited. Regarding the nature of the problem to be solved, the background section of the present invention provides the following:

“Accordingly, there is a need for a computerized medical records and billing system that allows for a doctor to view billing information on a real time basis with respect to the entry of services rendered at the time of the patient’s actual visit. Furthermore, what is needed is a computerized billing system and medical records system that allows for a patient to consult with the doctor during the procedure to determine not only the best possible medical service for the patient’s needs, but also the most effective and cost efficient medical service for the patient’s budget or means.” (see page 4, lines 8-15)

In contrast, the nature of the problem to be solved in Evans is different. Specifically, Evans provides:

“In the current environment, specific patient data is difficult to access when needed for analysis. The creation of patient data in remote locations exacerbates this problem. In addition, the wide variety of data formats for patient data hinders electronic processing and maintenance of patient files. Moreover, the use of a patient’s file by one healthcare provider can preclude its simultaneous use by another healthcare provider. Ongoing consolidation of healthcare providers into large health maintenance organizations (HMOs) and preferred provider organizations (PPOs) create issues in the transfer and maintenance of patient data in large enterprises having numerous remote locations. Under these circumstances, healthcare providers have difficulty providing effective treatment for their patients... The electronic medical record (EMR) system of the present invention automates and simplifies existing methods of patient chart creation, maintenance and retrieval.” (see col. 2, lines 5-24)

Likewise, the nature of the problem to be solved in Feldon is different. Specifically, Feldon provides:

"What is needed is a system which provides the advantages of pen-based systems and also provides complete, written reports from terse user input. The present invention fulfills this and other needs." (see col 1, lines 48-51)

Accordingly, the nature of the problem to be solved does not provide a motivation to combine all of the references cited by the Examiner since neither Evans nor Feldon addresses allowing a doctor to view billing information on a real time basis.

Regarding whether the teachings of the prior art provide a motivation to combine the references, neither Evans nor Feldon teach of a medical billing system. Instead, Evans teaches of an electronic medical record (EMR) system that creates and maintains all patient data electronically to eliminate or supplement creating and maintaining physical data records. (see col. 2, lines 22-30) Feldon teaches generating written reports based on input from a user to allow a user to document information by touching displayed data items on a screen with an electronic pen. From the user input, a complete written report is produced in full-text narrative form. (see col. 1, lines 54-60) Accordingly, Applicant respectfully submits that the teachings of the prior art do not provide a motivation to combine all of the references cited by the Examiner.

Regarding whether the knowledge of persons of ordinary skill in the art provide a motivation to combine the references, Applicant respectfully submits that the teachings of the four references cited in the Office Action are not sufficient for one of ordinary skill in the art at the time of the present invention to make the invention as presently claimed. This is evidenced, by example, through the current market response to the present invention. Thus, neither the nature of the problem solved, the teachings of the prior art, nor the knowledge of persons of

ordinary skill in the art provide a motivation to combine all of the references cited by the Examiner.

However, even if the references could be combined, M.P.E.P. 2143.01 indicates that the combination may not be sufficient to establish *prima facie* obviousness. Specifically, M.P.E.P. 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The prior art does not suggest the desirability of the combination as claimed by the present invention. Accordingly, a *prima facie* case of obviousness has not been established because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Thus, Applicant respectfully submits that claims 21-29, 31-38 and 40-41 as provided herein are not made obvious by the combination of Evans, Feldon, Lavin and Provost.

Additionally, Applicant respectfully submits that the requirement for "the prior art reference (or references when combined) must teach or suggest all claim limitations" is not met. For example, independent claim 33 includes a limitation of rendering the customizable form for

use in association with the healthcare provider performing one of the procedures from the pool of healthcare procedures on a patient, wherein the step for rendering the customizable form for use comprises: (i) indicating a selection of a diagnosis of the customizable form, (ii) indicating a selection of a procedure of the customizable form, and (iii) indicating any cost modification for the diagnosis or the procedure indicated on the customizable form different from a cost typically billed by the particular healthcare provider for the diagnosis or the procedure indicated on the customizable form. Applicant respectfully submits that none of the references alone or in any combination teaches a limitation of indicating any cost modification for the diagnosis or the procedure indicated on the customizable form different from a cost typically billed by the particular healthcare provider for the diagnosis or the procedure indicated on the customizable form. In contrast, such limitation is supported by the disclosure of the present invention as originally filed. For example, reference is made to page 24, lines 5-21, and Figures 15-16.

Accordingly, Applicant respectfully submits that claims 33-38 and 40-41 as provided herein are not made obvious by the combination of Evans, Feldon, Lavin and Provost.

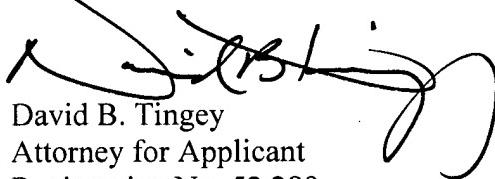
Thus, Applicant respectfully submits that the combination of Evans, Feldon, Lavin and Provost does not satisfy a *prima facie* case of obviousness of claims 21-29, 31-38 and 40-41 for at least the reasons that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings, and that the references do not teach or suggest all of the claim limitations.

## CONCLUSION

Applicant respectfully submits that the claim set provided herein does not add new matter and is now in condition for allowance. Accordingly, Applicant therefore requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

Dated this 8<sup>th</sup> day of July, 2005.

Respectfully submitted,

  
David B. Tingey  
Attorney for Applicant  
Registration No. 52,289

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 323-5986  
Facsimile: (801) 321-4893

:\ODMA\PCDOCS\DOCS\838302\1